

**REMARKS**

This paper is filed in response to the *Office Action* mailed November 29, 2006.

Claims 1-19 are pending in this application. Claims 1-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2002/0033795 to Shahoian (hereinafter referred to as “Shahoian”) in view of U.S. Patent No. 6,128,006 to Rosenberg et al (hereinafter referred to as “Rosenberg”).

Applicant has amended claims 14 and 17. No new matter is added by these amendments, and support may be found in the specification and claims as originally filed.

Applicant respectfully traverses the rejections of the claims. Reconsideration and allowance are respectfully requested in light of the amendments above and the remarks below.

**Claims 1-19 – § 103(a) – Shahoian in view of Rosenberg**

Applicant respectfully traverses the rejection of claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Shahoian in view of Rosenberg.

**Cited References Lack Each and Every Element of the Invention**

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the combined references must teach or suggest each and every element of the claimed invention. *See* M.P.E.P. § 2143.03. Further, if the proposed modification would render the reference being modified unsatisfactory for its intended purpose, then there is no motivation to make the proposed modification. *See* M.P.E.P. § 2143 (citations omitted).

Because Shahoian in view of Rosenberg does not teach or suggest “a touch-sensitive input device configured to move in a rotary degree of freedom” as recited in claim 1, 14, and 17, from which claims 2-13, 15-16, and 18-19 depend, claims 1-19 are patentable over the combined references. Shahoian does not teach “a touch-sensitive input device configured to move in a rotary degree of freedom.” On the contrary, on page 2 of the *Office Action*, the Examiner notes that Shahoian teaches a “touch-sensitive input device configured to move in an X and Y direction.” Movement in the X and Y direction is linear, and is not in “a rotary degree of freedom.” Rosenberg fails to cure this deficiency. As the Examiner notes on page 2 of the

*Office Action*, the wheel of Rosenberg “is not a touch sensitive device,” nor does Rosenberg teach or suggest a touch-sensitive device. Therefore, the combination of Shahoian and Rosenberg does not teach or suggest “a touch-sensitive input device configured to move in a rotary degree of freedom,” as recited in claims 1, 14, and 17.

Further, modifying Shahoian as the *Office Action* suggests would render Shahoian unsatisfactory for its intended purpose. On page 3 of the *Office Action*, the examiner notes that “it would have been obvious to one skilled in the art that a touchpad able to move in X and Y directions could also be configured to move in a rotational manner by providing a pivot point for the touchpad.” Applicant respectfully disagrees. First, as discussed above, there is no teaching or suggestion in Shahoian or Rosenberg to configure a touch-sensitive device with a pivot point for rotation. Second, providing a pivot point to a touch-sensitive device such as Shahoian would destroy its ability to move in the X and Y directions. Third, modifying Shahoian to rotate around a pivot point could limit the functionality of the touchpad, rendering the touchpad unsatisfactory for controlling the position of a cursor in a graphical environment. Thus, it would not be obvious to one skilled in the art to provide a pivot point to the touchpad of Shahoian.

Thus, claims 1, 14, and 17, from which claims 2-13, 15-16, and 18-19 depend, are patentable over the combined references. Applicant respectfully requests the Examiner withdraw the rejection of claims 1-19.

### **No Motivation To Combine**

Even assuming, arguendo, that the combination of Shahoian and Rosenberg teach or suggest every element of the claims, there is no motivation to combine the references. To sustain a rejection of a claim under 35 U.S.C. 103(a), there must be a motivation to combine the references. See M.P.E.P. § 2143.01.

Because one of ordinary skill in the art would not be motivated to modify Shahoian to incorporate the device of Rosenberg, claims 1, 14, and 17, from which claims 2-13, 15-16, and 18-19 depend, are patentable over the combination of Shahoian in view of Rosenberg. Shahoian discloses a touch-sensitive device. A user generally interacts with the Shahoian device by touching or sliding a finger across the device. Although the touch-sensitive device may be moved by an actuator, the device is not configured to be moved by the user, as the sliding movement of the finger across the touch-sensitive surface provides the input signal, rather than

the motion of the touch-sensitive surface itself. Rosenberg teaches a wheel input device, wherein the user rotates the wheel to provide an input signal. Rosenberg is not a touch-sensitive device. Rather, the Rosenberg wheel input device is a dial, or a rotary knob. A user generally interacts with the Rosenberg wheel input device by moving the wheel. The movement of the wheel itself, rather than the movement of the finger across the surface of the wheel, provides the input signal. One of ordinary skill in the art would not be motivated to modify the touch sensitive device of Shahoian to provide an input signal from the movement of the pad itself because it would fundamentally alter the mode of operation of the Shahoian device.

As stated, the Shahoian device generates input based on the touch or movement of the finger across the touch-sensitive surface, not the movement of the touch-sensitive surface itself. Were the touch-sensitive surface of the Shahoian device to be made movable by the user, the method of inputting data would be fundamentally changed – touch-sensitive input would be difficult or impossible since movement of the touch-sensitive surface could only be accomplished by engaging the touchpad with a finger, and arresting movement of the finger across the touchpad. To allow for movement of the touch-sensitive surface, the Shahoian device could not be readily touch sensitive. Making the touch sensitive surface of Shahoian movable by the user would fundamentally alter the mode of operation of the touchpad, and thus, one of ordinary skill in the art would not be motivated to modify the Shahoian device to provide for input based on the movement of the touchpad. Therefore, claims 1, 14, and 17, from which claims 2-13, 15-16, and 18-19 depend, are patentable over the combination of Rosenberg in view of Shahoian.

**CONCLUSION**

Applicant respectfully asserts that in view of the amendments and remarks above, all pending claims are allowable and Applicant respectfully requests the allowance of all claims.

Should the Examiner have any comments, questions, or suggestions of a nature necessary to expedite the prosecution of the application, or to place the case in condition for allowance, the Examiner is courteously requested to telephone the undersigned at the number listed below.

Respectfully submitted,

  
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